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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/195,333

11/17/1998

ERIC VALENTINE

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27045

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01/10/2006

ERICSSON INC.
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EXAMINER

SCHEIBEL, ROBERT C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/195,333	Applicant(s) VALENTINE ET AL.	
	Examiner Robert C. Scheibel	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- Applicant's Amendment filed 10/21/2005 is acknowledged.
- Claims 21-24, 28-33, and 37-38 are currently amended.
- Claims 21-39 are currently pending.

Response to Arguments

1. Applicant's arguments, see section "Examiner Objections – Claims" on page 7, filed 10/21/2005, with respect to objections to claims 23, 28, 29, 32, and 37 have been fully considered and are persuasive. The objections to claims 23, 28, 29, 32, and 37 have been withdrawn.
2. Applicant's arguments, see section "Claim Rejections – 35 U.S.C. 112" on page 7, filed 10/21/2005, with respect to the rejection of claims 21-39 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 21-39 under 35 U.S.C. 112 has been withdrawn.
3. Applicant's arguments with respect to the rejection of claims 21-39 under 35 U.S.C. 103(a) have been considered but are moot in view of the new grounds of rejection. However, since some of the same references are used in the rejection that follows, examiner provides the following comments regarding the arguments. The arguments on pages 7-8 summarize the invention and the Chavous and Kelly references. In the first full paragraph on page 9, applicant states that the unique aspect of the invention is the utilization of the IP address of the internet device to determine the device's location. The applicant further emphasizes that this determination is made using "the information required for registering the device with the ISP".

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However, examiner respectfully notes that this emphasized limitation is not included in the claim language. The present claim language is much broader than this and thus can be rejected as below. Applicant is urged to describe the invention (and specifically this limitation) in more detail in the claim language.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims **21-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,161,180 to Chavous in view of U.S. Patent Application Publication 2001/0055299 to Kelly and in further view of U.S. Patent 6,047,327 to Tso et al.

Regarding claims **21 and 30**, Chavous discloses the step of routing an emergency request message to an emergency call handling function (the combination of the call interceptor (CI) and

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the PBX of Chavous) in the panic button logic illustrated in elements 20 and 21 of Figure 2 as well as in the detection of the digits 9-1-1 in elements 17-19 of Figure 2. Chavous does not disclose the use of IP and as such does not use an IP address to identify a user. However, Chavous uses an extension number to identify the telephony device making the emergency request. Thus, the step of translating the IP address using information retrieved from an ISP is generally disclosed as the translation of the extension telephone number identifying the telephone into the location of the extension telephone using the interceptor's database (see lines 21-25 of column 3). Specifically, the step of retrieving information associated with the IP address (extension number) that includes a physical address and a PSAP compatible telephone number is disclosed in lines 21-40 of column 3; the physical address is the "location" described in lines 21-25 and 35-40 of column 3 and the PSAP number is inherent in that in order to dial PSAP as described in lines 30-34 the PSAP telephone number must be retrieved. The step of encapsulating the physical address information within a PSAP message for the PSAP is disclosed in lines 35-40 of column 3. The step of sending the emergency response message through the PSTN to the PSAP is also disclosed in lines 35-40 of column 3. The above limitations were largely described using the language of claim 21, but the equivalent means of claim 30 are similarly disclosed in Chavous.

Chavous does not disclose expressly the limitation that the emergency call handling function is connected to an ISP or the limitation of translating the IP address of the calling device to the physical location of the device.

However, at the time of the invention, it was well known that IP telephony could be used to provide many benefits such as reduced costs. Kelly is one example of this. Kelly discloses an

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IP telephone 232B of Figure 2 connected to a PBX. Clearly, this IP telephone would have an IP address in order to receive IP packets (see lines 5-8 of paragraph 38 on page 4, for example). As stated above, the PBX of Chavous was part of the emergency call handling function. Kelly thus discloses the limitation that the emergency call handling function is connected to an ISP as disclosed in Figure 2 (element 250A). Further, it is obvious that the IP address would have been used instead of an extension number. Chavous and Kelly are analogous art because they are from same field of endeavor of telephonic communication.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Chavous to use IP telephony instead of or in addition to circuit switched telephony and thus to use the IP address of Kelly instead of the extension number of Chavous. The motivation for combining the teaching of Kelly with Chavous would have been reduced cost as suggested by Kelly in the last 4 lines of paragraph 7 on page 1.

However, the combination of Chavous and Kelly does not disclose expressly the step of translating the IP address to a physical location using information from an ISP. Tso et al discloses the limitation of translating an IP address to a physical location in lines 11-13 of column 17. The database referred to in this passage is associated with the InfoCast server which provides an internet service.

The Chavous/Kelly combination and Tso are analogous art because they are from the same field of endeavor of locating a telecommunications user. At the time of the invention it would have been obvious to a person of ordinary skill in the art to determine the location of the emergency user of the Chavous/Kelly combination by translating the IP address in a manner similar to that of Tso. The motivation for doing so would have been to provide information

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based on the location of the user as suggested by Tso in lines 34-38 and 58-62 of column 1. The information on the user's location and thus the PSAP is clearly location dependent and thus this translation method of Tso is useful to the Chavous/Kelly combination. Therefore, it would have been obvious to combine Kelly with Chavous and with Tso for the benefit of reduced cost by using voice over IP to obtain the invention as specified in claims 21 and 30.

Regarding claims **22 and 31**, Chavous discloses the limitation of the encapsulating step further comprising the PSAP message including a telephone number of the PSAP assigned to a service zone covering the physical location in lines 30-34 of column 3; the PSAP number is clearly used to call the PSAP serving the calling telephone.

Regarding claims **23 and 32**, Chavous discloses the limitation of routing the PSAP message via a PSTN gateway (the PBX) into the PSTN and on to an appropriate central office (element 112) or a selected PSAP (108) in Figure 1.

Regarding claims **24 and 33**, Chavous discloses the limitation that the PSAP message is routed to the central office and the PSAP closest to the physical location associated with the Internet device (the calling telephone in Chavous as modified above) in lines 30-34 of column 3; it is well known that the PSAP serving the calling telephone is the closest PSAP.

Regarding claims **25-26 and 34-35**, Chavous, as modified above, discloses the limitation of the internet device having a static IP address as well as the limitation of the internet device having a dynamically assigned IP address. As discussed above, the Internet device (IP telephone 232B of Kelly) of Chavous modified by Kelly has an IP address. Lines 5-8 of paragraph 38 on page 4 disclose that this IP address is either static (fixed) or dynamically assigned.

Regarding claims **27 and 36**, Chavous, as modified above, discloses the limitation that the Internet device is a terminal in a LAN. The IP telephone 232A of Figure 2 can also be part of a LAN as described in the last 10 lines of paragraph 34 on pages 3-4 and illustrated in elements 275 and 232E of Figure 2.

Regarding claims **28 and 37**, Chavous, as modified above, does not explicitly disclose the limitation that the information associated with the IP address is associated in a database that includes account information required by the ISP to provide the Internet device access to the Internet, the information being associated with the user or subscriber and the Internet device. However, it does disclose that this information is located in a database (see lines 21-24 of column 3 of Chavous) and this includes information required to connect to the central office/PSAP. It is also clear that the PBX of Kelly must contain a database of information required for the user to access the Internet in order to effectively connect the ISP of Figure 2. At the time of the invention, it would have been obvious to one of ordinary skill in the art to store all this information related to the Internet device and the subscriber in one database. The motivation for doing so would have been to reduce the costs of the PBX system by reducing the memory requirements. Therefore, it would have been obvious to one of ordinary skill in the art to combine the location information of the calling telephone with information required to connect the device and user to the Internet for the benefit of reduced costs to obtain the invention as specified in claims **28 and 37**.

Regarding claims **29 and 38**, Chavous, as modified above, discloses the limitation that the call handing function is included within the PSTN gateway (the PBX) and that the gateway uses a protocol compatible with the emergency call answering center (the PSAP) to format a

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message containing the physical address associated with the Internet device (the calling telephone) in lines 35-40 of column 3 as discussed above.

Regarding claim 39, Chavous, as modified above, discloses the limitation of the emergency call handling function being a separate element outside the IP network maintained by a third party administrator in lines 54-59 of column 1 which indicate that the PBX represents one of many different types of devices including a Centrex which is maintained by a third party.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RCs 1-7-06
Robert C. Scheibel
Examiner
Art Unit 2666

Tommy
DANG TON
PRIMARY EXAMINER